UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,035	06/28/2001	Michael Baentsch	CH920000039US1 (14665)	5498

		EXAMINER
7590 08/15/2005		FAROOQ, MOHAMMAD O

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ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding. ¹

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/894,035	BAENTSCH ET AL.
		Examiner	Art Unit	
		Mohammad O. Farooq	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _13 May 2005_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-19_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-19_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _28 June 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☒ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections – 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or

composition of matter, or any new and useful improvement therefor, may obtain a patent thereof,

subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because:

Claims 1 and 9 recite as method for enabling a software acquiring entity to exchanging

two pieces of codes. This is an abstract idea since the code is not stored. The method as recited

can be done by a person as a mental step or using pencil and paper. Claims 13 and 15-19 recite a

code amendment enabler which is program product (software, per se) without any hardware to

enable their functionality to be realized by causing a computer to perform steps which would

provide a useful, concrete and tangible result. The claims as recited are not necessarily machine

implemented. Therefore the method and computer program product of claims 1-13 and 15-19 as

recited are not provided in a manner to which would enable its functionality to perform steps

which provide a useful, concrete and tangible result.

Claim 14 recite a computer readable medium having the code of claim 13. The computer

readable medium is not limited to tangible embodiments. In view of Applicant's disclosure,

specification page 9, line 20 to page 10 line 2, the medium is not limited to tangible

embodiments, instead being defined as including both tangible embodiments (e.g., magnetic

storage disk) and intangible embodiments (e.g., printed form, printers and scanner which is

similar to code in a piece of paper). As such, the claim is not limited to statutory subject matter

and is therefore non-statutory.

To overcome this type of 101 rejection, it is suggested that the claim is amended to recite

"A tangible computer readable storage medium" instead.

To expedite a complete examination of the instant application, the claims rejected under

35 USC 101 (nonstatutory) above are further rejected as set forth below in anticipation of

applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 1 of claim 1 the applicants recites method and do not state which are the steps necessary to carry out the method. Furthermore in lines 4 and 5 the applicant recites steps. It's unclear what steps are considered necessary to arrive from the 1st piece of code to the 2nd piece of code. The applicants are required to make appropriate corrections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Nachenberg, U.S. Pat. No. 6,230,316.

4.   As to claim 1, Nachenberg teach method for a software provider (25) of enabling a

software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a

second signed piece of code (12,13), both pieces of code (11,12,13) having been granted by use

of a first software archive generator (2) under use of generation instructions (8), comprising the

step of providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference

between two versions; col. 1, lines 34-52) comprising the steps necessary to arrive from said first

signed piece of code (11) at said second signed piece of code (12,13), which difference code

(4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-

acquiring entity (20) to b e combined with said first signed piece of code (11) by a second

software archive generator (7) to generate said second signed piece of code (11) by a second

software archive generator (7) to generate said second signed piece of code (12, 13), whereby

said second software archive generator (7) is to be fed with those generation instructions (8) that

were used by said first software archive generator (2) for the generation of both pieces of code

(11, 12, 13) (abstract; fig. 8; col. 5, line 36- col. 6, line 17).

5.   As to claim 2, Nachenberg teach method, wherein the generation instructions (8) are

provided to the software-acquiring entity (20) by the software provider (25), together with the

second software archive generator (7) (inherent; col. 1, lines 12-26).

6.   As to claim 3, Nachenberg teach method, wherein the pieces of code are signed using a

private key (inherent; col. 1, line 65 – col. 2, lines 24).

7.   As to claim 4, Nachenberg teach method, wherein the signed pieces of code (11, 12, 13)

are stored in a storage unit (1) at the software provider (25) (see fig. 8; col. 1, lines 12 – 59).

8.   As to claim 5, Nachenberg teach method, wherein the difference code (4,5) (i.e.

incremental updates) is created, by the first software archive generator (2), while said first

software archive generator (2) generates the second signed piece of code (12, 13) (inherent; col.

1, line 34 – col. 2, line 24).

9.   As to claim 6, Nachenberg teach method, wherein for more than two pieces of code (11,

12, 13) being stored, the difference code (4,5) is generated only between a subset of said pieces

of code (11, 12, 13) (inherent; see fig. 8).

10.   As to claim 7, Nachenberg teach method, wherein for arriving from the first piece of code

(11) to the second piece of code (13) several difference codes (4, 5) are required, these difference

codes (4,5) are merged into a single difference code (i.e. update file; see fig. 8) to be provided to

the software-acquiring entity (20) (col. 1, line 53 – col. 2, lines 24; col. 5, line 34 – col. 6, line

17).

11.   As to claim 8, Nachenberg teach method, wherein the first and second piece of code (11,

12, 13) are identified at the software provider (25) by deriving a corresponding identifier from a

request (16) received from the software-acquiring entity (20) (inherent; col. 1, line 12 – col. 2,

line 24).

12.   As to claim 9, Nachenberg teach method for a software-acquiring entity (20) of arriving

from an existent first signed piece of code (11) at a second signed piece of code (12, 13), both

pieces of code (11, 12, 13) having been generated at a software provider (25) by use of a first

software archive generator (2) under use of generation instructions (8), comprising the steps of

-        sending a code amendment request (16) to said software provider (25) for the delivery of

a difference code (4,5) which comprises the steps necessary to arrive from said first signed piece

of code (11) at said second signed piece of code (12, 13) (inherent; col 1, lines 34-52),

-        receiving said difference code (4,5) (i.e. update; fig. 8; col. 1, line 12 – col. 2, line 24),

-        combining said difference code (4,5) with said first signed piece of code (11) by use of a

second software archive generator (7), thereby generating said second signed piece of code (12,

13), whereby said second software archive generator (7) is fed with those generation instructions

(8) that were used by said first software archive generator (2) for the generation of both pieces of

code (11, 12, 13) (col. 1, line 34 – 52; col. 5, line 36 – col. 6, line 17).

13.   As to claim 10, Nachenberg teach method, wherein the generation instructions (8) are

received from the software provider (25), together with the second software archive generator (7)

(inherent; col. 1, lines 12-26).

14.   As to claim 11, Nachenberg teach method, wherein the pieces of code (11, 12, 13) are

signed by use of a private key (14) and the signature (Sig 11, Sig 12, Sig 13) is verifiable by use

of a corresponding public key (15) (inherent; col. 1, line 65 – col. 2, lines 24).

15.   As to claim 12, Nachenberg teach method, wherein the first and second pieces of code

(11, 12, 13) are identified by the software-acquiring entity (2) by giving a corresponding

identifier in the code amendment (i.e. update) request (16) (col. 1, line 12 – col. 2, line 24; col.

5, line 34 – col. 6, line 17).

16.   As to claim 13, Nachenberg teach computer program product comprising program code

means for performing a method for a software provider (25) of enabling a software-acquiring

entity (20) to arrive from an existent first signed piece of code (11) at a second signed piece of

code (12,13), both pieces of code (11,12,13) having been granted by use of a first software

archive generator (2) under use of generation instructions (8), comprising the step of providing to

said software-acquiring entity (20) a difference code (4,5) (i.e. difference between two versions;

col. 1, lines 34-52) comprising the steps necessary to arrive from said first signed piece of code

(11) at said second signed piece of code (12,13), which difference code (4,5) (i.e. difference

between two versions; col. 1, lines 34-52) is usable at said software-acquiring entity (20) to b e

combined with said first signed piece of code (11) by a second software archive generator (7) to

generate said second signed piece of code (11) by a second software archive generator (7) to

generate said second signed piece of code (12, 13), whereby said second software archive

generator (7) is to be fed with those generation instructions (8) that were used by said first

software archive generator (2) for the generation of both pieces of code (11, 12, 13) (abstract;

fig. 8; col. 5, line 36- col. 6, line 17).

17.   As to claim 14, Nachenberg teach computer program product, comprising the program

code means stored on a computer-readable medium for a software provider (25) of enabling a

software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a

second signed piece of code (12,13), both pieces of code (11,12,13) having been granted by use

of a first software archive generator (2) under use of generation instructions (8), comprising the

step of providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference

between two versions; col. 1, lines 34-52) comprising the steps necessary to arrive from said first

signed piece of code (11) at said second signed piece of code (12,13), which difference code

(4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-

acquiring entity (20) to b e combined with said first signed piece of code (11) by a second

software archive generator (7) to generate said second signed piece of code (11) by a second

software archive generator (7) to generate said second signed piece of code (12, 13), whereby

said second software archive generator (7) is to be fed with those generation instructions (8) that

were used by said first software archive generator (2) for the generation of both pieces of code

(11, 12, 13) (abstract; fig. 8; col. 5, line 36- col. 6, line 17).

18.	As to claim 15, Nachenberg teach code amendment enabler comprising

-	a difference code generator (10) for generating a difference code (4,5) that comprises the

steps necessary to arrive from said first signed piece of code (11) at said second signed piece of

code (12, 13), which difference code (4,5) is usable at said software-acquiring entity (2) to be

combined with said first signed piece of code (11) by a second software archive generator (7) to

generate said second signed piece of code (12, 13), whereby said second software archive

generator (7) is fed with the generation instructions (8) (abstract; fig. 8; col. 1, line 12- col. 6,

line 24; col. 5, line 36 – col. 6, line 17),

-	an output unit (3) for providing to said software-acquiring entity (2) said difference code

(4,5) (inherent; see fig. 8; col. 5, line 36 – col. 6, line 17).

19.	As to claim 16, Nachenberg teach code amendment enabler, further comprising an input

unit (24) (inherent) for receiving from said software-acquiring entity (20) a code amendment

request (16) for the delivery of said difference code (4,5) (col. 5, line 36 – col. 6, line 17).

20.	As to claim 17, Nachenberg teach code amendment enabler, further comprising a first

software archive generator (2) for generating said pieces of code (11, 12, 13) under use of

generation instructions (8) (col. 1, lines 12 – 65).

21.   As to claim 18, Nachenberg teach code amendment device, comprising

-    a second software archive generator (7) for combining a received difference code (4,5)

with said first signed piece of code (11), thereby generating said second signed piece of code (12,

13) , whereby said second software archive generator (7) is to be fed with those generation

instructions (8) that were used by said first software archive generator (2) for the generation of

both pieces of code (11, 12, 13) (inherent; col. 1, line 12 – col. 2, line 24; col. 5, line 36 – col. 6,

line 17).

22.   As to claim 19, Nachenberg teach code amendment device, further comprising an

input/output unit (6) for sending a code amendment request (16) to said software provider (25)

and for receiving said difference code (inherent since updates are developed and sent via floppy

or CD-ROMs; col. 1, line 12 – 26).

Response to Arguments

23.   Applicant's arguments filed May 13, 2005 have been fully considered but they are not

persuasive.

24.   The examiner disagrees with the applicant Nachenburg fails to disclose or suggest

providing to a software-acquiring entity, such as a user, a difference code and the use of a second

software archive generator that is fed with generation instruction that were used by a software

archive generator for generating both first and second pieces of code. The examiner would like

to point to col. 5, line 36 – col. 6, line 17; specifically col. 5, lines 36-59; wherein 100B or first

version and 100C or second version is used by update builder 122 to generate update or

difference file 124C-B. Later, this update or difference file 124C-B is used with 100B or first

version by another update builder or updater 128 to generate 100C which is second version. It is

to be noted that the mechanism or the generation instructions for both updater or update builder

122 and 128 are the same.

After considering the above facts, the examiner retains the rejection all of the previously

rejected claims.

25.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad O. Farooq whose telephone number is (571) 272-

4144. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad O. Farooq
August 8, 2005

KIM HUYNH
PRIMARY EXAMINER

5/11/05